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CONCERNING APPLICATION:

Applicant(s):	John S. Yates, Jr., et al.		
Serial No.:	09/385,394	Art Unit:	2183
Filed:	August 30, 1999	Examiner:	Richard Ellis
Title:	COMPUTER WITH TWO DIFFERENT EXECUTION MODES		

AFTER FINAL – EXPEDITED PROCEDURE

I hereby certify that the attached

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- Supplement to Petition of April 8, 2004

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PATENT

ATTORNEY DOCKET NO. 114596-03-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.:	09/385,394	Confirmation No.:	9093
Applicant:	John S. Yates, Jr., et al.		
Title:	COMPUTER WITH TWO DIFFERENT EXECUTION MODES		
Filed:	August 30, 1999		
Art Unit:	2183		
Examiner:	Richard Ellis		
Atty. Docket:	114596-03-4000		
Customer No.	38492		

I certify that this correspondence, along with any documents referred to therein, is being transmitted by facsimile on June 14, 2005 to Art Unit 2183 at FAX no. 703 872 9306, and deposited with the United States Postal Service on June 14, 2005 as First Class Mail in an envelope with sufficient postage addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dan E. Boe

AFTER FINAL – EXPEDITED PROCEDURE

SUPPLEMENT TO PETITION OF APRIL 8, 2004

Mail Stop AF
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P.O. Box 1450
Alexandria, VA 22313-1450

This Supplement to Petition comments on an Advisory Action of June 7, 2005 and provides additional information relevant to the issues raised in the "Petition to Reopen prosecution" of April 8, 2005, specifically section IV (pages 9-10) of that Petition.

Background:

The Petition of April 8, 2005 notes that final rejection is premature because, among other reasons: (a) certain references filed on Forms 1449 in reliance on 37 C.F.R. § 1.9(d) (additional copies of references need not be supplied when copies exist in parent files) were not considered, and (b) by the Examiner's own admission, examination on the merits was not completed in the Office Action of October 2004.

These facts are undisputed. (1) A copy of WO 99/08188 (Kelly) was of record in the file of 09/239,194 as of October 2004, and available to the Examiner in this case. (2) the IDS filed July 12, 2004 complied in every respect with 37 C.F.R. §1.98(d), under the ordinary interpretation of 35 U.S.C. § 120.

The June 2005 Advisory Action states that the Kelly '188 reference was not considered because no copies were made available in the file wrapper of an application "relied on for an earlier effective filing date under 35 U.S.C. § 120," and asserts that 09/239,194 is not such an application.

Issues:

The June 2005 Advisory Action frames two disputes: (a) whether any Form 1449 has ever been returned to Applicant indicating that the WO '188 reference has been considered, and (b) whether the 09/239,194 application is "relied upon for a filing date under 35 U.S.C. § 120" to allow reliance under 37 C.F.R. § 1.98(d) on copies of WO '188 in the file of the '194 Application.

Two further disputes are brought into focus by the silence of the June 2005 Advisory Action: (c) The Examiner is unable to identify any Patent Office procedure that permits cure of omissions in a "final" Office Action through subsequent Advisory Actions, and (d) the term "new ground of rejection" is in dispute, all written authority (Federal Circuit and the Board) on one hand, and the Examiner opposed. Under all precedential definitions of "new ground of rejection," final rejection is premature.

Dispute 1: The '194 Application Is "Relied Upon ... Under 35 U.S.C. § 120"

Paragraph 3 of the June 2005 Advisory Action (see pages 3-5) explains the position taken in earlier Office Actions, that the WO '188 reference was not considered because "the only application for which this application relies upon for a filing date under 35 USC § 120 is parent case 09/322,443" and therefore references in the file of 09/239,194 are not eligible to be considered under 37 C.F.R. § 1.98(d).

The Examiner indicates no basis for his legal conclusion that the '194 application is not a § 120 parent. There is none. For example, the first paragraph of this application reads as follows (underline added):

> This application claims priority from U.S. applications serial no. 09/322,443, filed May 28, 1999, serial no. 09/298,536, filed April 23, 1999, and serial no. 09/239,194, filed January 28, 1999. ...

The priority claim to 09/239,194 is reiterated in the "Utility Application and Application Fee Transmittal" letter of August 30, 1999. The Patent Office has acknowledged the priority claim on the Official Filing Receipt and in the PAIR record of this application.

The Examiner does not explain the basis for his disagreeing with the rest of the PTO. His view is contrary to law and unsupported by even a scintilla of evidence. Final rejection based on that erroneous view of law must be vacated.

Dispute 2: Has the WO '188 Publication Ever Been Considered?

There is no dispute that WO 99/08188 was timely cited in both 09/239,194 and this application on Forms 1449 that comply with all requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98, and that no Form 1449 has ever been returned with the WO '188 reference initialed. The Advisory Action makes no attempt to show otherwise.

Instead, paragraph 2 of the June 2005 Advisory Action offers only a *non sequitur*, that a different WO patent publication (WO 99/08191) was considered.

The Examiner does not offer any genuine dispute that examination of this application has not been completed. The legal conclusion necessarily follows: final rejection was premature.

Dispute 3: Can Omissions from the October 2004 Office Action be Cured in Advisory Actions?

There is no dispute that consideration of a number of issues has been untimely:

- Over a dozen references were not timely checked off on Forms 1449, even though these references had been cited in conformance with all applicable rules long before October 1994.
- As the Examiner himself acknowledges in ¶¶ 3 and 4 of the February Advisory Action, the discussion of claims 22 and 104 in the October "final" Office Action was simply wrong or incomplete, and that discussion had to be replaced or supplemented in the Advisory.
- The February and June Office Actions make no attempt to fill in a number of other silences in the Office Actions noted in Applicant's papers.

No Patent Office rule provides an examiner any authority to cure omissions in a "final" Office Action, while maintaining finality of that Office Action. No authority grants an Examiner authority to delay fully stating his view until an Advisory Action; indeed, all relevant authority is

opposed, and has long required the PTO to fully explain itself on paper before final rejection. *E.g.*, *In re Wiechert*, 370 F.2d, 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) ("[W]hen a rejection is factually based on an entirely different portion of an existing reference," that is a "new ground of rejection"). "Final" sauce for the applicant goose is final for the examiner gander. 35 U.S.C. § 3(a)(2)(A) (Director's duties, including examination under § 131, are to be performed "equitably"). If an examiner finds he must take some action that shows that examination was not "finally" completed, then finality must be withdrawn.

Dispute 4: The Correct Definition of "New Ground of Rejection" Is Uncontested, and Demonstrates that Finality of the October 2004 Office Action is Premature

In a "Request to Withdraw Finality of Office Action" of April 14 at pp. 3-4, Applicant requested the Examiner reconsider his position in view of Federal Circuit and Board definitions for "new ground of rejection." Under this definition, the Office Action of October 2004 raises "new grounds of rejection" of claims 104 and 87 "not necessitated by amendment." *See also* Petition of Apr. 8, 2005 at § II; Request to Withdraw Finality of Jan. 25, 2005 at pp. 4-5.

The June 2005 Advisory is simply silent in reply. The two Advisory Actions have simply ignored the established definition of "new ground of rejection," and substituted an improvised, unauthorized one. *See, e.g.*, Advisory Action of June 2005 (silence throughout); Advisory Action of Feb. 2005 ¶ 5 (stating conflicting definition of "identical" ground of rejection). No authority is cited in support. After some research, it appears that no authority exists to overrule the Federal Circuit and Board definitions cited in Applicant's papers.

Examiners lack the authority to disregard written rules, or redefine established terms of PTO practice. Final rejection was imposed in excess of the Examiner's authority.

Issue Withdrawn

The issue relating to U.S. patents raised in section III.B of the Petition of April 14, 2005 is withdrawn.

Conclusion

This application has been extraordinarily delayed by Examiner Ellis' refusal to follow the written rules, especially rules that require an examiner to fully articulate his position. There is no dispute that examination of this application has been neither complete nor timely. MPEP §§ 706.07 and 706.07(a) provide that the procedural consequences of incomplete and untimely examination are to be borne by the examiner, not an applicant.

Finality of the Office Action of October 2005 should be withdrawn for the reasons stated in the Petition of April 8, 2005, as modified here, so that the amendment of April 25, 2005 may be entered.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: June 14, 2005

By: _____

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